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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,709	12/02/2003	Teruaki Itoh	160-400	2216
23117	7590	03/29/2007	EXAMINER	
NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			BEX, PATRICIA K	
			ART UNIT	PAPER NUMBER
			1743	
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary	Application No.	Applicant(s)	
	10/724,709	ITOH, TERUAKI	
	Examiner P. Kathryn Bex	Art Unit 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 May 2005.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-4 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-4 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 01 December 2003 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/2005, 12/2003</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed May 04, 2005 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance of the JP- 07-35437 reference, which is not in the English language. The information disclosure statement should include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. The aforementioned reference has been placed in the application file, but the information referred to therein has not been considered.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a) because they fail to show the "container collecting position 14" recited in claim 1 and described in the specification at page 5, lines 19-21. In addition, the drawings do not clearly illustrate the "carry-out mechanism 30" recited at page 8, line 15 of the instant specification.

Reference no. 30 (i.e., carry-out mechanism) does not appear linked to any particular part in the Figures. It is not clear what applicant considers the "carry-out mechanism 30". Similarly, it is not clear from the figures what reference no. 33 is illustrating, as this does not appear to be a "conveyor" as known in the art. The figures should clearly illustrate the "carry-out conveyor" 33 capable of "automatically" carrying out the specimen container.

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Claim 3, lines 4-5, recites a first partition plate and a second partition plate that are vertically opposed to each other. Figures 1 and 2 do not illustrate the partition plates "vertically opposed", rather they are angled downwardly with respect to a horizontal plane. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d).

3. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

All of the instant claims recite "the" after a previously recited limitation. This raises the question of sufficient antecedent basis for these claim limitations. For example, claim 1, line 11, "the container collecting position", this should be change to -- said container collecting position--, to conform with current U.S. patent practice. Applicant is required to thoroughly inspect all of the claims and make appropriate corrections.

Moreover, instant claim 1, lines 4-8, is confusing and indefinite since the claim appears to recite the removal of the containers from the collection position through the insertion port of the storing box. This is not supported by the specification or Figures. Rather, the Office believes the outlet is used to discharge the specimen containers from the storing box. Furthermore, line 12 of claim 1, recites "along one side wall". It is not clear from the claim what side wall Applicant is referring to. For examination purposes, this has been interpreted as the side wall of the storing box. For clarity, Applicant should

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consider rewriting claim 1 to clearly recite a container storing box having a plurality of side walls, an insertion port and a bottom; said bottom of said container storing box including a tapered surface having a container collecting position in the lowest part thereof to collect a plurality of tube-type specimen containers.

With respect to claim 1, line 12, the phrase "close to" in the above referenced claims is a relative term that renders the claims indefinite. The phrase "close to" is not defined by the claims, nor does the specification provide a standard for ascertaining the requisite degree. Thus, one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. How close is the side wall to the container collecting position?

Claim 3, lines 4-5, recites a first partition plate and a second partition plate that are "vertically opposed" to each other. It is not clear how the first and second partition plates are vertically opposed. Moreover, figures 1 and 2 do not illustrate the partition plates "vertically opposed", rather they are angled downwardly with respect to a horizontal plane.

Clarification/correction of all the aforementioned is respectfully requested.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Yuyama et al. (US Patent No. 6,138,868), hereinafter Yuyama.

Yuyama teaches an automatic tube-type specimen container supply apparatus comprising; a container storing box 1 having an insertion port (top opening of the container; Fig. 1), and a bottom 1a with a tapered (slanted) surface creating a container collecting position in a lowest part thereof to collect a plurality of tube-type specimen containers A. The Yuyama apparatus also includes a container individually-sending mechanism 2 configured to lift up the specimen containers collected in the container collecting position one-by-one along one side wall 5 located close to the container collecting position. The apparatus has an outlet 5x formed in the one side wall to discharge the specimen containers outside the storing box lifted up by the container individually-sending mechanism, and a container carry-out mechanism including a carry-out conveyor 26 to automatically carry out the specimen containers discharged through the outlet.

The container individually-sending mechanism of Yuyama includes a lifting plate 2 driven up and down by a drive source (motor 12); the lifting plate has a top end with a tapered surface 7 descending toward an outside of the container storing box (Fig. 5). Note that the surface area of 7 allows for only one specimen container lying on a side thereof (i.e., no side-by-side containers), although multiple containers may be disposed end-to-end on the lifting plate. The claim language does not preclude the containers being disposed end-to-end on the lifting plate.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishizuka (JP 2002-306952).

Ishizuka teaches an automatic tube-type specimen container supply apparatus comprising; a container storing box 1 having an insertion port (top opening of the container; Fig. 1), and a bottom with a tapered (slanted) surface creating a container collecting position in a lowest part thereof to collect a plurality of tube-type specimen containers D. The Ishizuka apparatus also includes a container individually-sending mechanism 22 configured to lift up specimen containers collected in the container collecting position along one side wall 34 located approximate to the container collecting position. The apparatus has an outlet 34a formed in the one side wall to discharge the specimen containers outside the storing box lifted up by the container individually-

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sending mechanism, and a container carry-out mechanism including a chute 5, which acts as a conveyor since it automatically carries out the discharged specimen containers.

The container individually-sending mechanism of Ishizuka includes a lifting plate 22 driven up and down by a drive source (motor 23); the lifting plate has a top end with a tapered surface 22a descending toward the outside of the container storing box (Fig. 5). With respect to claim 2, Ishizuka also teaches an auxiliary plate 21 mounted on one side of the lifting plate such that the auxiliary plate is slidable up and down relative to the lifting plate (Figs. 4a-d). The auxiliary plate of has a top end with a tapered surface that descends toward the outside of the container storing box, the top end of the auxiliary plate being flush with that of the lifting plate when the lifting plate descends (Fig. 4c) and being located in a lower level than that of the lifting plate when the lifting plate ascends (Fig. 4b).

Ishizuka does not teach the tapered surface of the lifting plate having space to place a single specimen container in a side-by-side manner. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified the teachings of Ishizuka so that the tapered surface of the lifting plate only has enough space to place one specimen container in a side-by-side manner to prevent the outlet from becoming jammed with too many containers. Furthermore, it has been held that where the only difference between the prior art and the claims is a recitation of relative dimensions of the claimed device, the dimensions are considered a matter of choice which a person of ordinary skill in the art would have found obvious

absent persuasive evidence that the particular configuration of the claimed device is significant, see MPEP 2144.04 and *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984).

11. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishizuka in view of Portyansky (US Patent no. 4,567,997).

The teachings of Ishizuka have been summarized previously, *supra*. Ishizuka does not specifically disclose the container storing box having a two-layer structure including a first partition plate and a second partition plate that are vertically opposed to each other. The first partition plate having a tapered surface that descends from one side to the other side, and the second partition plate having a tapered surface that descends in a direction opposite to the tapered surface of the first partition plate, and a path is formed between the first and second partition plates to allow one specimen container to pass therethrough.

Portyansky teach a stick delivery mechanism (Fig. 1) comprising, *inter alia*, a container storing box 12 having a two-layer structure including a first partition plate 16 and a second partition plate 22, 24 that are vertically opposed to each other. The first partition plate having a tapered (slanted) surface that descends from one side to another side, and the second partition plate having a tapered (slanted) surface that descends in a direction opposite to the tapered surface of the first partition plate, and a path 26 is formed between the first and second partition plates to allow one specimen container to pass therethrough.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified the teachings of Ishizuka to include the partition configuration, as taught by Portyansky, in order to help prevent more than one container from disposal through the outlet so as to prevent the outlet from becoming blocked by too many containers simultaneously flowing therethrough.

12. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yuyama in view of Miner (US Patent no. 488,084).

The teachings of Yuyama have been summarized previously, *supra*. Yuyama does not specifically teach the use of an auxiliary plate mounted on one side of the lifting plate such that the auxiliary plate is slidable up and down relative to the lifting plate. The auxiliary plate has a top end with a tapered surface that descends toward an outside of the container storing box, the top end of the auxiliary plate being flush with that of the lifting plate when the lifting plate descends and being located in a lower level than that of the lifting plate when the lifting plate ascends.

Miner also teaches an auxiliary plate C mounted on one side of the lifting plate such that the auxiliary plate is slidable up and down relative to the lifting plate (Figs. 1 and 3). The auxiliary plate of has a top end with a tapered surface that descends toward an outside of the container storing box, the top end of the auxiliary plate being flush with that of the lifting plate when the lifting plate descends and being located in a lower level than that of the lifting plate when the lifting plate ascends.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified the teachings of Yuyama to include an auxiliary plate, as taught by Miner, in order to help move the containers through the outlet while preventing the outlet from becoming blocked by too many containers.

Miner does not teach the tapered surface of the lifting plate having space to place only one specimen container in a side-by-side manner. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified the teachings of Miner so that the tapered surface of the lifting plate only has enough space to place one specimen container so that the outlet does not become jammed with too many containers. Furthermore, it has been held that where the only difference between the prior art and the claims is a recitation of relative dimensions of the claimed device, the dimensions are considered a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed device was significant, see MPEP 2144.04 and *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984).

13. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yuyama in view of Portyansky (US Patent no. 4,567,997).

The teachings of Yuyama have been summarized previously, *supra*. Yuyama does not specifically disclosed the container storing box having a two-layer structure including a first and a second partition plate that are vertically opposed to each other.

The first partition plate having a tapered surface that descends from one side to another side, and the second partition plate having a tapered surface that descends in a direction opposite to the tapered surface of the first partition plate, and a path is formed between the first and second partition plates to allow one specimen container to pass therethrough.

Portyansky teach a stick delivery mechanism (Fig. 1) comprising, *inter alia*, a container storing box 12 having a two-layer structure including a first partition plate 16 and a second partition plate 22, 24 that are vertically opposed to each other. The first partition plate having a tapered (slanted) surface that descends from one side to the other side, and the second partition plate having a tapered (slanted) surface that descends in a direction opposite to the tapered surface of the first partition plate, and a path 26 is formed between the first and second partition plates to allow one specimen container to pass therethrough.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified the teachings of Yuyama to include the specific partition configuration, as taught by Portyansky, in order to help prevent more than one container from being disposed through the outlet so as to prevent the outlet from becoming blocked by too many containers simultaneously flowing therethrough.

14. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yuyama in view of Miner, as applied to claim 2 above, and further in view of Portyansky.

The combined teachings of Yuyama and Miner, have been

summarized previously, *supra*. The combined teachings of Yuyama and Miner do not specifically disclose the container storing box having a two-layer structure including a first and a second partition plate that are vertically opposed to each other. The first partition plate having a tapered surface that descends from one side to another side, and the second partition plate having a tapered surface that descends in a direction opposite to the tapered surface of the first partition plate, and a path is formed between the first and second partition plates to allow one specimen container to pass therethrough.

Portyansky teach a stick delivery mechanism (Fig. 1) comprising, *inter alia*, a container storing box 12 having a two-layer structure including a first partition plate 16 and a second partition plate 22, 24 that are vertically opposed to each other. The first partition plate having a tapered (slanted) surface that descends from one side to another side, and the second partition plate having a tapered (slanted) surface that descends in a direction opposite to the tapered surface of the first partition plate, and a path 26 is formed between the first and second partition plates to allow one specimen container to pass therethrough.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified the teachings of combined teachings of Yuyama and Miner to include the partition configuration, as taught by Portyansky, in order to help prevent more than one container from disposal through the outlet so as to prevent the outlet from becoming blocked by too many containers simultaneously flowing therethrough.

Conclusion

15. No claims allowed.
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Bex whose telephone number is 571-272-2374. The examiner can normally be reached on Monday thru Thursday, 9 AM to 6 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

pkb


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